

REMARKS

As an initial matter, Applicant thanks the Examiner for indicating that claims 14-16 and 55 contain allowable subject matter. Claims 1-111 are currently pending in this application, with claims 1, 43, 64, 80, and 96 being independent. Claims 13, 17-19, 28-32, 52-54, 56-60, 63, 73, 74, 89, 90, 105, and 106 have been withdrawn from consideration. Because each of the withdrawn claims depends from one of independent claims 1 and 43, Applicant submits that, upon allowance of claims 1 and 43, the withdrawn claims should be rejoined and also allowed.

By this Amendment, Applicants propose amending independent claims 1 and 43. The proposed amendments do not introduce any new matter.

In the Office Action, claims 1-12, 20-27, 33-51, 61, 62, 96-98, 101-104, and 107-111 were rejected under either 35 U.S.C. § 102(e) or 35 U.S.C. § 103(a) in view of U.S. Patent No. 6,508,603 to Vasas; and claims 64-66, 69-72, 75-82, 85-88, and 91-95 were rejected under U.S.C. § 103(a) over Vasas in view of U.S. Patent No. 5,937,870 to Gueret.

Independent claim 1 is directed to a device for applying a product to keratinous fibers and recites, among other things, “a stem having two opposite ends” and “a brush portion connected to one end portion of the stem, the one end portion of the stem having a longitudinal axis . . . wherein the brush portion comprises a core having a core free end . . . and a longitudinal axis of the core free end is not parallel to the longitudinal axis of the one end portion.” Independent claim 43 is directed to a method of making an applicator for applying a product to keratinous fibers and recites, among other things, “curving at least a part of the blank core so as to form a brush portion comprising a core having a core free end and a brush portion free end not aligned with a longitudinal axis

of an end portion of a stem to which the brush portion is adapted to be connected, wherein . . . a longitudinal axis of the core free end is not parallel to the longitudinal axis of the end portion when the brush portion is connected to the end portion of the stem."

Vasas discloses a mascara brush configured for loading from a sidewall of a mascara container. In particular, Vasas discloses a mascara brush and container wherein a brush 30 is secured to a distal end 28 of a rod 26. The brush 30 has a stem 32 and a plurality of radially extending bristles 34. The stem 32 is bent into a first portion 32a which extends outwardly from a longitudinal axis A of the rod 26 and bottle 12 and a second portion 32b which extends downwardly and is substantially parallel to and offset from the axis A. Vasas discloses that the bristles 34 extending from the stem portion 32b, which includes a free end, have sufficient length such that their tips either touch or lie closely adjacent to the sidewall 14 of the bottle 12. (Col. 2, lines 32-46). Vasas further teaches that the portion of the brush 30 including the stem 32b has a diameter B of about 0.25 inches and just touches the sidewall 14 and that the length of the bristle portions placed against the sidewall is preferably limited, so as not to greatly distort the brush or result in a permanent bend of the bristles 46 if stored for a period of time. (Col. 2, lines 47-49 and col. 3, lines 24-38).

Each of the embodiments shown and described in Vasas has a brush portion having over approximately half of its length or more, including the free end portion of the brush, a uniform, cylindrical cross-section. Such a configuration achieves the desired result disclosed in Vasas to have all the bristles over that portion (including the free end) of the brush lightly contacting the side wall of the bottle 12 so as to scrape the mascara therefrom, without being too short such that they are spaced too far from the side wall

so as to not achieve the desired scraping or being too long so as to distort and potentially permanently bend the bristles.

Vasas does not disclose or otherwise suggest, among other things, that a longitudinal axis of a free end of the core is not parallel to the longitudinal axis of the one end portion of the stem. Rather, Vasas discloses exactly the opposite. That is, in Fig. 1 and at col. 2, lines 38-44, for example, Vasas teaches that the portion 32b which includes the free end of the brush is parallel to the longitudinal axis of the stem 32. The embodiments of Figs. 2-4 also include this feature.

For at least this reason, therefore, independent claims 1 and 43, as amended, and their respective dependent claims, are patentably distinguishable from Vasas, and the Section 102 and 103 rejections based on Vasas should be withdrawn.

Regarding the rejection of independent claim 96 based on Vasas, Vasas fails to disclose or otherwise suggest at least a brush portion comprising “bristles comprising ends defining an envelope surface having a cross-section that continuously varies from the free end of the brush portion to a location along the length of the brush portion,” as recited in claim 96. Indeed, in the Office Action, the Examiner has not explained how Vasas discloses this aspect. To the contrary, instead of disclosing a bristle end envelope surface having a cross-section that continuously varies from the free end of the brush portion to a location along the length of the brush portion, Vasas discloses a brush portion having a constant diameter from a free end of the brush to a location along the length of the brush that is at least midway along the brush length. In other words, an envelope surface defined by the bristle ends of the brush portion of each of the embodiments in Vasas is a cylindrical surface from a free end to at least a

midportion of the brush portion and therefore the cross-section is constant over at least a portion of the brush from the free end to a location along its length, rather than continuously varying, from a free end to a location along the length.

For at least this reason, therefore, claim 96, and its dependent claims, are patentably distinguishable from Vasas, and the rejections of those claims based on Vasas should be withdrawn.

Regarding the Section 103 rejection of independent claims 64 and 80, and their respective dependent claims, based on Vasas in view of Gueret, the Office Action fails to establish a *prima facie* case of obviousness.

The Office has the initial burden of presenting a *prima facie* case of unpatentability. To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), three basic criteria must be met. First, the prior art references when combined must teach or suggest all the claim elements. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Finally, there must be a reasonable expectation of success. See M.P.E.P. § 2143. Moreover, if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification and a *prima facie* case of obviousness cannot be established. See M.P.E.P. § 2143.01, citing In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). As discussed below, the Office Action's asserted combination of Vasas and Gueret fails to establish a *prima facie* case of unpatentability under 35 U.S.C. § 103(a).

At least the second criterion above, i.e., a motivation to modify the references in the manner suggested in the Office Action, has not been satisfied in this case. More specifically, there is no motivation to modify the cylindrical brush portion of Vasas with the noncylindrical or varying cross-section brush portions allegedly disclosed in Gueret, as the Office Action suggests, because to do so would destroy the principle of operation taught by Vasas, a clear violation of the case law and M.P.E.P. § 2143.01.

As discussed above, Vasas teaches a brush portion that has bristles wherein the length of the bristles of the brush portion including the free end to about midway or more along the length of the brush portion must be of substantially uniform and sufficient length such that all of the bristle tips lightly touch the interior surface of the bottle containing the mascara. The length is critical to the operation of the Vasas mascara brush since the stated object in Vasas is to provide a brush wherein over a length of the brush from the free end, the bristles can scrape mascara from the sides of the bottle. To provide a variable cross-section over this portion of the brush would result in some bristles being either too short such that they would not perform the desired scraping function or too long such that they would deform and potentially become permanently bent (which Vasas explicitly warns against). Thus, Vasas explicitly teaches against having bristles that are nonuniform in length over a length of the brush including the free end portion because that would result in bristles being too short and/or too long such that they would not perform the desired amount of contacting and scraping explicitly described in Vasas. As such, there is no motivation to modify Vasas with Gueret in the manner suggested in the Office Action. For at least this reason, therefore, the Office

Action fails to establish a *prima facie* case of obviousness and the Section 103 rejection based on Vasas and Gueret should be withdrawn.

Claims 2-42, 44-63, 65-79, 81-95, and 96-111 and depend from one of claims 1, 43, 64, 80, and 96, and therefore should be allowable for at least the same reasons those respective independent claims are allowable. In addition, at least some of the dependent claims recite unique features and/or combinations that are not taught by the prior art and therefore at least some also are separately patentable.

Applicant respectfully requests that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 1-111 in condition for allowance. The proposed claim amendments do not raise issues requiring further consideration or necessitate the undertaking of any additional search of the art by the Examiner. Therefore, this Amendment should allow for immediate action by the Examiner.

Furthermore, Applicant respectfully points out that the final action by the Examiner presented some new arguments as to the application of the art against Applicant's claims. Entering the Amendment would allow the Applicant to reply to the final rejections and place the application in condition for allowance.

Finally, entry of the claim amendments would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

Applicant requests the entry of the claim amendments, the withdrawal of the outstanding claim rejections, the rejoinder of withdrawn claims 13, 17-19, 28-32, 52-54, 56-60, and 63, and the allowance of pending claims 1-111.

The Office Action contains characterizations and conclusions regarding the prior art and Applicant's claims with which Applicant does not necessarily agree. Unless

expressly noted otherwise, Applicant declines to subscribe to any such characterizations and conclusions.

Please grant any extensions of time required to enter this Amendment and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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